

## II. REMARKS

### Status of the Claims

Claims 1-10 are submitted for reconsideration.

### Summary of the Office Action

Claims 1-3 and 10 stand rejected under 35USC103(a) on the basis of the cited reference Toshihiko, JP5-37619 in view of the teaching of Hsu, U.S. Patent No. 5,694,468. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks. Claims 4-9 are objected to as dependent on a rejected claim.

### Discussion of the Cited References

The Examiner has cited the new reference Toshihiko in support for the rejection based on obviousness in combination with the teaching of Hsu.

The reference Toshihiko shows a holder for a cellular phone. This holder has rigid sidewalls (18, 21), which are used to guide the phone into its locked position ( see Fig. 1). These side walls have inward extending projections that engage the phone as shown in figure 5. This is in addition to the clamping of element 24 into the notch constructed in the phone body as shown in figure 6. This overall configuration necessarily restricts the use of the holder of Toshihiko to phones having the dimensions matching this particular holder (in practice only one size phone is possible).

The way in which the phone is locked in the holder is depicted in Fig. 5. It is quite clear that two small hooks of the holder are attached to a recessed part in the phone. Both components must

be rigid to fulfill the locking function. Therefore it is doubtful whether Toshihiko, if modified by proposals made by the Examiner, could keep the phone in the modified holder only by friction force if the soft hooks of Hsu replace the rigid hooks of Toshihiko.

The modification of Toshihiko is rendered even less plausible when the inward projections, shown as item 21 in figure 2, are considered. Even if the rigid hooks of Toshihiko are replaced by the soft hooks of Hsu the holder would still be usable with only a single phone shape because of the engagement of side walls 21. This defeats any incentive asserted by the Examiner to combine the references to obtain more generic usefulness.

In the rejection, the Examiner characterizes the combined teachings of Toshihiko and Hsu as follows:

"However, Hsu's flat clamping surfaces are more generic, Hsu's design is to hold different sizes/models of phones, not just one specific phone. Therefore, it would have been obvious for one of ordinary skill in the art to use Toshihiko as it is if the user just wants to hold one type of phone, or to modify Toshihiko's clamping/locking stem portions with a flat clamping surface as taught by Hsu, this modification allows the holder to hold a phone of any size and any type at its two clamping surfaces (col. 1, lines 42-45 in Hsu)"

In this manner the Examiner ignores the fact that the clamping mechanism of Toshihiko relies on the engagement of the phone by the holder at several interfaces on the phone and that these interfaces would have to be eliminated in order for the combination of teachings to be meaningfully accomplished. Applicant submits that such extensive redesign of the holder of Toshihiko would not be obvious or even desirable to a person skilled in the art.

These arguments are further supported by the enormous differential in the size of the elements of the cited teachings. There is not enough space to utilize the large soft clamps of Hsu(see Fig. 1) with the holder of Toshihiko. If large soft clamps are utilized the sidewalls (18) must first be removed in order to enable the movement of the clamps. Moreover, if the sidewalls are removed, then the ratched-type mechanism of Hsu (which is not hinged) becomes a more desirable alternative. A detailed review of the combination proposed by the Examiner moves further and further away from the teaching of Toshihiko.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The Examiner has searched for features of the claimed invention in the prior art teachings and then has proceeded to force the combination of such teachings with out regard to the teachings themselves. The combined teachings therefore take on a significance beyond that which would be contemplated by a person skilled in the art. This is far beyond the theory of obviousness


contemplated by 35USC103.

SUMMARY

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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